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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,116	02/25/2004	Iris Pecker	27674	1402
7590	01/24/2008		EXAMINER	
Martin D. Moynihan PRTSI, Inc. P. O. Box 16446 Arlington, VA 22215			HUTSON, RICHARD G	
			ART UNIT	PAPER NUMBER
			1652	
			MAIL DATE	
			01/24/2008	DELIVERY MODE
				PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/785,116	PECKER ET AL.
	Examiner	Art Unit
	Richard G. Hutson	1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 32-48,50-52,54 and 59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 32-48 and 59 is/are allowed.
- 6) Claim(s) 50-52 and 54 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_.

### **DETAILED ACTION**

The following action is to replace the office action sent to applicants on 12/20/2007. This action is necessitated to correct a mistake with respect to those claims which were previously not recognized as cancelled. This mistake which is regretted, was brought to applicants attention by Mr. David Spolter, #36933) and confirmed by Mr. Spolter on 1/22/2008.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/25/2007 has been entered.

Applicant's cancellation of claims 49, 53 and 55-58 and the amendment of claims 50-52 and 54, in the paper of 9/25/2007 is acknowledged. Claims 32-48, 50-52, 54 and 59 are at issue and are present for examination.

Applicants' arguments filed on 9/25/2007, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

***Information Disclosure Statement***

Applicant's submission of the information disclosure statement on 10/10/2007, is acknowledged. Those references considered have been initialed. The 1449 was previously mailed to applicants.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 50-52 and 54 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated polynucleotide comprising the nucleotide sequence of SEQ ID NO: 43, does not reasonably provide enablement for a transgenic organism comprising a host cell recombinantly expressing the polypeptide of SEQ ID NO: 44. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

This rejection was stated in the previous office action as it applied to previous claims 49, 53, 55 and 56-58. In response to this rejection, applicants have cancelled claims 49, 53 and 55-58 and amended claims 50-52 and 54 and traverse the rejection on the basis that it applies to the newly amended claims. This rejection which was

previously made is applied to claims 50-52 and 53 for the same reasons previously made for claims 49, 53 and 55-58.

Applicants reiterate the previously made basis of the rejection of the current claims as applicant's specification is not enabled for a transgenic organism comprising a host cell recombinantly expressing SEQ ID NO: 44. Applicants submit that they are extremely puzzled by this allegation. Applicants puzzled state is noted, however, surprising as the basis of this rejection may be to applicants, it was first made in the office action of 9/25/2006, page 6, line 4 and reiterated in the office action of 3/19/2007. As was previously stated, the claims encompass whole transgenic organisms comprising the referred to "host cells" and applicants are not enabled for such transgenic organisms.

Applicants submit that the rejected claims are directed to a host cell, not a transgenic organism and the fact that these claims may encompass an inoperative embodiment does not matter under the law. See, for example, M.P.E.P. sec. 2164.08(b). Applicants submit that the vast majority of embodiments encompassed by these claims are to host cells but not transgenic organisms.

Applicants amendment of the claims and there traversal of the current rejection is acknowledged and has been carefully considered, however, is found non-persuasive on the following basis. First applicants claim that any transgenic organism encompassed within the claimed genus are "inoperative embodiments" is not persuasive.

Applicants have not provided sufficient guidance to enable one of ordinary skill in the art to make and use the claimed invention in a manner reasonably correlated with the scope of the claims broadly including the encompassed host cells as part of a transgenic organism. The scope of the claims must bear a reasonable correlation with the scope of enablement (*In re Fisher*, 166 USPQ 19 24 (CCPA 1970)). Without sufficient guidance, guidance to make and use those host cells of a transgenic organism is unpredictable and the experimentation left to those skilled in the art is unnecessarily, and improperly, extensive and undue. See *In re Wands* 858 F.2d 731, 8 USPQ2nd 1400 (Fed. Cir, 1988).

It is suggested that if it is applicants intent to exclude transgenic organisms from applicant's claims that applicants amend the claims to recite "An isolated host cell..."

### ***Conclusion***

This is a continuation of applicant's earlier Application No. 10/785,116. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G. Hutson whose telephone number is 571-272-0930. The examiner can normally be reached on M-F, 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number:  
10/785,116  
Art Unit: 1652

Page 7



Richard G Hutson, Ph.D.  
Primary Examiner  
Art Unit 1652

rgh  
1/22/2008